

**AMENDMENT TO THE DRAWINGS**

The attached drawing sheets include changes to Figures 1 and 2B. These sheets, which include Figure 1 and Figure 2B respectively, replaces the previous sheets including Figure 1 and 2B.

Attachment: Replacement Sheets

### **REMARKS/ARGUMENTS**

Claims 1-4, 13, 15, 16, 25 and 27-49 are now pending in this application. Claims 1, 15, 27 and 38 are independent claims. Claims 5-12, 14, 17-24 and 26 have been cancelled without prejudice. Claims 27-49 were previously withdrawn pursuant to the Restriction Requirement dated February 24, 2005.

#### ***Specification***

The disclosure was objected to due to informalities. (Office Action, Pages 2-3). Amendments have been made to the specification, thereby obviating the objections under this section.

#### ***Drawings***

The drawings were objected to due to informalities. (Office Action, Page 3). Amendments have been made to the specification and the drawings, thereby obviating the objections under this section. The drawings were further objected to under 37 CFR 1.83(a). (Office Action, Pages 3-4). Claims 5-12, 14, 17-24 and 26 have been cancelled, thereby obviating the objections under this section.

#### ***Claim Rejections – 35 USC § 112***

Claims 5-12, 14, 17-24 and 26 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement, and were further rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. (Office Action, Pages 4-6). Claims 5-12, 14, 17-24 and 26 have been cancelled, thereby obviating the rejections under this section. Claims 2 and 15 were also rejected under 35 U.S.C. § 112,

second paragraph, as being indefinite. (Office Action, Pages 5-6). Applicants would respectfully like to point out that the term “adjustment assembly” as used in claims 2 and 15 is believed to be sufficiently described in paragraph [0016] from page 7, lines 11-25 of the present application so as to be compliant with 35 U.S.C. § 112, second paragraph.

***Claim Rejections – 35 USC § 102***

Claims 1, 3, 4, 13, 15, 16 and 25 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Chen USPN: 6,431,428 (hereinafter: Chen). Applicants respectfully traverse these rejections.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, “anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Independent Claims 1 and 15 each include elements that have not been disclosed, taught or suggested by Chen. Claims 1 and 15 each generally recite:

“a pick-off pivot assembly coupled to the housing, the pick-off pivot assembly for pivotally coupling the housing to the nail driving assembly and providing the nail to the nail driving assembly, wherein the pick-off pivot assembly enables the nail loading assembly to be positioned at various angles relative to the nail driving assembly and presents the nail to the nail driving assembly in the correct position.”

The Patent Office asserts that Chen discloses a pick-off pivot assembly as claimed in the present application. (Office Action, Page 7). Applicants respectfully disagree. Chen teaches a pivot for pivotally connecting a magazine and a barrel of a pneumatic nail gun. (Chen, Column 2, Lines 16-17). However, no reference number, nor any further description of the pivot is provided in Chen. The present invention claims a pick-off pivot assembly coupled to the housing of the nail loading assembly (ex.-the magazine).

In Chen, it is not discussed whether or not the purported pick-off pivot assembly (i.e.-the pivot) is coupled to the magazine or the barrel. Further, the pick-off pivot assembly, as claimed in the present application, is configured to present nails to the nail driving assembly in the correct position. In the present application, detailed description of the structure of the pick-off pivot assembly and how said structure allows the pick-off pivot assembly to provide such functionality is disclosed. (Present Application, Page 8, Paragraph 0018; Page 12, Paragraph 0028; and Page 13, Paragraph 0029; *See also*: FIGS. 4A-7). For example, the structure of the pick-off pivot assembly of the present invention terminates the track of a nail just before the nail enters a driver blade bore. (Present Application, Page 12, Paragraph 0027). This results in nails being “picked-off” of the nail strip and presented in a better (“correct”) firing position as compared to conventional nail guns, which allow the nail to contact an opposite wall of the driver blade bore. (Present Application, Page 12, Paragraph 0027 and Page 13, Paragraph 0029). Nowhere in Chen is such structure providing the above-described functionality either disclosed, taught or suggested.

Therefore, based on the above rationale, it is contended that Chen does not teach, suggest, or disclose the above-referenced elements of Claims 1 and 15 of the present application. Under *Lindemann*, a *prima facie* case of anticipation has not been established for Claims 1 and 15. Thus, independent Claims 1 and 15 should be allowed. Dependent Claims 2-4 and 13 (which depend on independent Claim 1) and dependent Claims 16 and 25 (which depend on independent Claim 15) should also be allowed.

### **CONCLUSION**

In light of the forgoing, reconsideration and allowance of the pending claims is earnestly solicited.


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Amendment & Response to Office Action dated 06-13-05

Respectfully submitted on behalf of

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